

REMARKS

The claims in this application are claims 2-6. Those claims have been finally rejected under 35 USC § 103 as being unpatentable over Green, Sullivan and O'Lenick combined. This rejection is respectfully traversed.

The examiner's characterization of the here claimed invention as "no more than a selective combination of prior art teachings done in a manner obvious to one of ordinary skill in the art" is incorrect on the record in this case.

A comparison of working examples 5, 7 and 8 with comparative example 5 in the present specification represents a direct comparison with the closest prior art. That comparison demonstrates that when the catalyst of the instant claims is used with no intervening removal of catalyst and no addition of free radical inhibitors, a much higher yield is obtained than when a prior art catalyst is used under otherwise identical conditions.

As has been argued previously, when free radical inhibitors are added to the reaction in O'Lenick, higher yields are obtained than when they are absent. As pointed out previously, the present claims preclude the presence of free radical initiators and in the working examples of O'Lenick where free radical initiators are not used, the yields are inferior to those obtained in the working examples of the invention in the present specification.

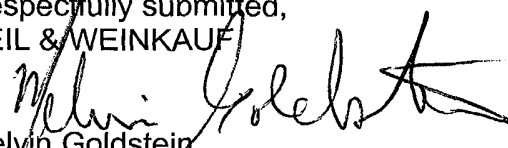
The claims previously on appeal did not exclude the presence of free radical initiators as clearly as the present claims do. The examiner has relied on dicta in the

previous Board decision. At page 7 of the previous decision, in the discussion of the significance of the language "consists essentially of" the Board may have been correct. However, on page 8, the discussion beginning "Even if we were to accept" is dicta and does not truly apply to the present fact situation. Although O'Lenick teaches that the process can be carried out with or without free radical inhibitors, that reference does disclose reduced yields without free radical inhibitors. That reference in no way suggests that with a different type of catalyst, i.e., the one recited in applicants' claims, no free radical inhibitor would be necessary to obtain even the highest possible yields. Thus, applicants' position does not require that O'Lenick be read only with respect to its preferred embodiments.

In light of the foregoing comments, it is believed that the rejection of record does not apply to the claims as amended in this application, and allowance is respectfully solicited.

Please charge any shortage in fees due in connection with the filing of this paper, including Extension of Time fees to Deposit Account No. 11-0345. Please credit any excess fees to such deposit account.

Respectfully submitted,
KEIL & WEINKAUF


Melvin Goldstein
Reg. No. 41,560

1350 Connecticut Ave., N.W.
Washington, D.C. 20036
(202)659-0100
MG/kas

COMPLETE LISTING OF ALL CLAIMS IN THE APPLICATION

1. (canceled)
2. (previously amended) A process as claimed in claim 6, wherein the catalyst used in the first step is a diazabicycloalkene of the formula Ia

where from 1 to 4 hydrogen atoms on the diazabicycloalkene nucleus may be independently replaced by the radicals R¹ to R⁴, in which case R¹, R², R³ and R⁴ are each C₁₋₂₀-alkyl, C₆₋₂₀-aryl or C₇₋₂₀-arylalkyl, and n is an integer from 1 to 3.
3. (previously amended) A process as claimed in claim 6, wherein the catalyst used in the first step is 1,5-diazabicyclo(4.3.0)non-5-ene (DBN), 1,5-diazabicyclo(4.4.0)dec-5-ene (DBD) or 1,8-diazabicyclo(5.4.0)undec-7-ene (DBU).
4. (previously amended) A process as claimed in claim 6, wherein the catalyst in the first step is used in an amount of from 0.05 to 5% by weight, based on the alcohol.
5. (previously amended) A process as claimed in claim 6, wherein the reaction of the first step is carried out at from 25 to 100°C.
6. (previously amended) A process for preparing a γ -alkoxyamine by
 - a) reaction of an α,β -unsaturated nitrile with a monohydric, dihydric or trihydric alcohol in the presence of a basic catalyst at from -20 to 200°C, optionally in the presence of a solvent, to form a β -alkoxynitrile, and
 - b) subsequent hydrogenation of the β -alkoxynitrile in the presence of a

hydrogenation catalyst, optionally in the presence of a solvent, without prior removal or neutralization of said basic catalyst, which consists of using in the first step a diazabicycloalkene catalyst of the formula I

where from 1 to 4 hydrogen atoms on the diazabicycloalkene nucleus may be independently replaced by the radicals R^1 to R^4 , in which case R^1 , R^2 , R^3 and R^4 are each C_{1-20} -alkyl, C_{6-20} -aryl or C_{7-20} -arylalkyl, and n and m are each an integer from 1 to 6, and effecting the hydrogenation in the second step at from 50 to 250°C in the presence of a hydrogenation catalyst and of the catalyst of the formula I.